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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/806,087 | 03/22/2004 | Rajan Rajendran | 0315-000505/REA | 1688 |

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| EXAMINER |
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RODRIGUEZ, WILLIAM H

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| ART UNIT | PAPER NUMBER |
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3746

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| MAIL DATE | DELIVERY MODE |
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09/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
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| Office Action Summary | Application No. 10/806,087 | Applicant(s) RAJENDRAN ET AL. | |
| | Examiner /William H. Rodriguez/ | Art Unit 3746 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,71,75-95,97,99-102,104-106 and 108-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,71,75-95,97,99-102,104-106 and 108-120 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the amendment and remarks filed 1/25/02. In making the below rejections, the examiner has considered and addressed each of the applicants arguments.

Specification

1. The specification is objected to because: Changes were made to the original patent by a Certificate of Correction on 3/3/04, which is prior to the filing of the reissue. The applicant has failed to incorporate into the reissue application the changes made to the specification and claims by this certificate. Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue patent document as part of the original patent, i.e., not in italics or bracketed. Appropriate correction is required.

Claim Objections

2. Claim 8 is objected to because of the following informalities: Changes were made to the original patent by a Certificate of Correction on 3/3/04, which is prior to the filing of the reissue. The applicant has failed to incorporate into the reissue application the changes made to the specification and claims by this certificate. Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue patent document as part of the original patent, i.e., not in italics or bracketed. Appropriate correction is required.

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3. Claim 76 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

There appears to be an issue of possible recapture regarding the phrase/claim limitation of the "suction pressure zone". This limitation was added in the original patent by the amendment filed on 7/3/03 and was additionally argued by the applicant in the accompanying remarks as basis for the claimed invention defining over the applied art. The applicant has now attempted to remove this limitation in at least some instances from newly presented claim 76.

Oath or Declaration Defective

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

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5. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.
6. Claims 1-29, 71, 75-95, 97, 99-102, 104-106 and 108-120 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.
7. Claims 1-29, 71, 75-95, 97, 99-102, 104-106 and 108-120 are rejected as being based upon a defective reissue oath or declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath or declaration is set forth in the discussion above in this Office action.

First, only two inventors are indicated on the oath yet the patent has three listed inventors. Carl H. Knapke is not listed at all.

Second, the specific statement of error is not sufficient for multiple reasons. First, since this is broadening, the applicant needs to state as such here but has failed to do so. Also, applicant currently indicates that one error is that they "did not claim the subject matter of an oil sump disposed along a cylindrical sidewall..." however as this limitation is only presented as a dependent claim, it is not sufficient basis for a reissuable error. Next, applicant indicates that they did not claim the subject matter of claim 30 in communication with the mounting frame assembly, discharge pressure chamber, capacity modulation, variable speed motor, fluid injection, eccentric crank pin, suction inlet, oil pump, and end caps. This is also not sufficient error: there is no claim currently pending that incorporates claim 30 and all of these listed elements; therefore if this is really an error, it has still not been fixed and is insufficient basis for the reissue. Applicant must provide a specific statement of error that accurately describes an error sufficient for reissue that is in fact being corrected by the reissue; applicant must identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid (i.e. is too broad/narrow) and must do so with *specific reference to a specific phrase/expression and a specific original claim*.

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Third, this appears to be a broadening reissue in that the claims are broader in at least one respect as compared to the scope of the claims of the patent; a broadening reissue application must be applied for by all of the inventors (patentees) and the oath must be signed by all inventors. In this instance, applicant has filed a declaration by the assignee which is not acceptable in a broadening reissue.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /William H. Rodríguez/ whose telephone number is 571-272-4831. The examiner can normally be reached on Monday-Friday 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Rodríguez/
Primary Examiner
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